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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,721	10/04/2001	Otto Lenherr	4780-19	3049
2352	7590	03/30/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			STAIKOVICI, STEFAN	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/971,721

Applicant(s)

LENHERR, OTTO

Examiner

Stefan Staicovici

Art Unit

1732

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 26-86.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See attachment.

## **ATTACHMENT TO ADVISORY ACTION**

### ***Response to Amendment***

1. Applicant's After-Final amendment filed March 21, 2005 has not been entered will not be entered because the proposed amendments raise new issues that would require further consideration and also, since the proposed amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, incorporating the limitation of "plastically shape-forming the supporting core out of a preform that is cast in a rough-shape of a final supporting core shape, the preform having at least an equal mass with the supporting core being manufactured" previously presented in claims 27-29, into independent claims 26 and 67, introduces subject matter in a combination which has not been previously presented and as such would require further consideration. These noted proposed amendments neither overcome the applied rejections nor clarify the claimed invention.

Claims 26-86 are pending in the instant application.

### ***Response to Arguments***

2. Applicant's arguments filed in the After-Final amendment of March 21, 2005 have been considered.

Applicant argues that the art of record does not teach or suggest a "supporting core with low tolerances" or the process of making said core "at a temperature which is similar or equal to the temperature which occurs during the RTM process" (see pages 12-13 of the After-Final amendment filed March 21, 2005). In response to applicant's argument it is noted that the

features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the Examiner's assertion that "the limitation of resin transfer molding is a functional limitation and does not carry patentable weight" is invalid because the "claims are drawn to a process" and as such "functional steps do carry patentable weight" (see page 13 of the After-Final amendment filed March 21, 2005). In response to applicant's arguments, the recitation "*for use in manufacturing fiber-reinforced components in a Resin-Transfer-Molding (RTM) process*" (emphasis added) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the *purpose of a process or the intended use* (emphasis added) of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is noted that the above stated limitation has not been given patentable weight only in claim 67, and not in claim 26, where positive process steps of the resin transfer molding process are being claimed.

Applicant argues that in *Vandas* ('884) and JP 61-016817 the "formed mass itself is not pre-shaped" in that "it is not in the rough form of the final shape, as in the presently claimed invention" (see page 13 of the After-Final amendment filed March 21, 2005). However, as noted above, incorporating the limitation of "plastically shape-forming the supporting core out of a

preform that is cast in a rough-shape of a final supporting core shape, the preform having at least an equal mass with the supporting core being manufactured” previously presented in claims 27-29, into independent claims 26 and 67, introduces subject matter in a combination which has not been previously presented and as such would require further consideration. Further, it is noted that JP 61-016817 specifically teaches forming a wax article by compression molding (plastic deformation) of a core wax preform (15), whereas Vandas ('884) teaches forming a wax article by compression molding (plastic deformation) a core mass (see col. 7, lines 2-10 and 20-30). Therefore, both references teach forming a core by compression molding, hence plastic deformation.

### *Conclusion*

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

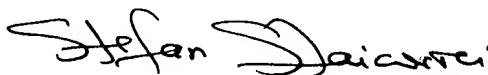
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD

A handwritten signature in black ink that reads "Stefan Staicovici". The signature is written in a cursive, flowing style.

Primary Examiner

3/25/05

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March 25, 2005